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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,860	10/02/2003	Bernd Greifeneder	06896/100M098-US1	2441

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EXAMINER	
ABEL JALIL, NEVEEN	

ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	**Application No.** 10/678,860	**Applicant(s)** GREIFENEDER ET AL.
	Examiner Neveen Abel-Jalil	**Art Unit** 2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14, & 16-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14, & 16-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-April -2006 has been entered.

2. The amendment filed on 5-April -2006 has been received and entered. Claim 15 has been cancelled. Therefore, claims 1-14, and 16-20 are now pending.

Claim Objections

3. Claims 1-6, 9-10, 12, and 19 are objected to because of the following informalities:

In claims 1-6, 10, and 19, various lines, the recitation of "*for*" is intended use, never actually takes place, therefore renders any recitation claimed after not be given patentable weight. Claims should be amended to recite more direct and positive language such as "to", "which", "that", or "managing". Appropriate correction is required.

Claim 9, line 3, recite "if" in various location which is language that suggest optionally making the recitation following never actually having to take place since its optional and thus will not have any patentable weight if it never has to happen. Claims should be amended to recite more direct, firm language such as "wherein" or "when".

Claim 12, line 1, recite "MIS" which is an acronym that must be spelled out.

Regarding claim 1, The Examiner points to MPEP 2106 [R-2] wherein the claim's recitation of "operable to" raises the question to Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Office personnel must rely on the applicant's disclosure to properly determine the meaning of ** the claims. Limitations appearing in the specification but not recited in the claim are not read into the claim; therefore, in this case, the recitation of "operable to" as interpreted in light of the specification provide the "functionality" or "the capability" of the database management system to perform the steps without definite disclosure limiting or excluding any alternative, negative, or even all together suggest actually performing or implementing the functionality that is database management system is capable of.

Therefore, any cited art that teaches the steps otherwise in the alternative can be used to reject the instant application. The computer being operable to perform a function does not mean that it will ever actually perform that functionality (i.e. "operable to" should be clarified and changed to a more definite term such as "configured to", "which" or "is").

Applicant's recitation of "configuration comprising a service table, a detection table, and a metric table" in the Independent claims, appears to have been intended to be in a Markush type form (closed). Thus claims should be amended to recite "consisting of" or "including" to give all three distinct tables patentable weight. Otherwise, under the recitation "comprising" all that is claimed is three tables that can include any information. As such, correction is required.

In Gillette Co. v. Energizer Holdings Inc., 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005), the court held that a claim to "a safety razor blade unit comprising a guard, a cap, and a group of first, second, and third blades" encompasses razors with more than three blades because the transitional phrase "comprising" in the preamble and the phrase "group of" are presumptively open-ended. "The word comprising' transitioning from the preamble to the body signals that the entire claim is presumptively open-ended." Id. In contrast, the court noted the phrase "group consisting of" is a closed term, which is often used in claim drafting to signal a "Markush group" that is by its nature closed. Id.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 is not statutory because it merely recite a

number of computing steps without producing any tangible result and/or being limited to a practical application (see MPEP 2106 IV.B.2.(b)) i.e. Software per se.

Claim 1, although, reciting "a computer program" in the preamble, there is no mention of a computer or any processing taking place in either the preamble nor in the body of the claim in order for the steps to be stored or transformed and realized its functionality (on a computer or any other hardware). There's no other mention of the program being stored or executed by a hardware device (computer or processor) and no indication that the program is anything being anything other than software. There's no mention of the module being anything other than software implementation in the body of the claim and no indication as to what constitute a concrete tangible embodiment.

Furthermore, there is no tangible embodiment of any hardware tied to limitations of the claim.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 5, and 16, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's language of "enabling" a computer to do something -in claim 5 preamble- is not prohibiting and does not cause any functionality to occur in the computer and thus failing to particularly point out and distinctly claim their invention (it's unclear what Applicant's intended metes and bounds of the claim are, since the claim appears to cover anything and everything that does not prohibit actions from occurring). Claims should be amended to recite more definite language such as “configured to”, “which” or “is”.

Claim 1, line 15, the recitation of “the detected metrics” (plural) lacks antecedent basis.

Claim 19, line 2, recite “its” which is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear to the Examiner what is being referenced by “its”. Correction is required.

Claim 16, line 2, include the recitation “to be examined” which is vague and indefinite for not be clear on what constitute part of the range and how is it being examined and to what end is the range being examined related to the remaining claimed recitation. Clarification is required.

Claim 18, line 3, include the recitation “empty and are populated” making it vague and confusing on how it the change has taken place? And what constitute empty then populated? And what the reference is exactly directed to? Clarification is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-14, and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Moran et al. (U.S. Patent No. 6,633,835 B1).

As to claim 1, Moran et al. discloses a computer program for managing and monitoring one or more computer systems, said computer program comprising:

a data source detection module for identifying avaible data sources in said one or more computer systems and for detecting at least one metric related to at least one of the available data sources (See column 38, lines 26-30); and

a configuration operable to utilized by said data source detection module to acquire instructions for querying at least one of said computer systems, said configuration comprising a service tale, a detection table, and a metric table for specifying possible combinations of said data sources in said one or more computer systems (See column 17, lines 31-58, also see column 38, lines 27-30);

wherein said data source detection module scans said one or more computer systems and outputs a list of the available data sources in said scanned computer systems (See column 17, lines 31-58, also see column 38, lines 27-30);

said list comprising a subset of said possible combinations of said data sources specified by said configuration (See column 37, lines 56-67, and see column 38, lines 1-30, for all possibility of collected information); and

wherein the data source detection module outputs a list of the detected metrics (See column 38, lines 26-30).

As to claim 2, Moran et al. discloses wherein the data sources are monitoring information sources (See column 5, lines 36-54).

As to claim 3, Moran et al. discloses further comprising:

a monitoring information service for providing monitoring information of one of said computer systems (See column 44, lines 62-67); and

a probe engine for probing said service (See column 6, lines 1-5).

As to claim 4, Moran et al. discloses further comprising data collection tools for collecting performance information from said data sources, said data collection tools allowing said user to choose said data sources for monitoring (See column 17, lines 1-29).

As to claim 5, Moran et al. discloses comprising a graphical user interface for enabling a user to interact with said data source detection module and said data collection tools (See column 38, lines 43-65).

As to claim 6, Moran et al. discloses a method for automatic detection of monitoring data sources of at least one computer system, said method comprising the steps of:

providing a configuration containing instructions for querying at least one of said computer system, said configuration comprising a service table, a detection table, and a metric table for specifying possible combinations of said data sources in at least one of said computer systems (See column 17, lines 31-58, also see column 38, lines 27-30);

providing a data detection module (See column 17, lines 31-58, also see column 38, lines 27-30);

said data detection module identifying, by using said configuration, available data sources of at least one of said at least one computer system (See column 17, lines 31-58, also see column 38, lines 27-30);

collecting meta and performance information of said available data sources of at least one of said at least one computer system (See column 37, lines 56-67, and see column 38, lines 1-30, for all possibility of collected information);

embedding an expert's knowledge into a generic configuration in software used in said step of collecting meta and performance information (See column 19, lines 15-20, and see column 42, lines 36-60, also see column 44, lines 50-67);

presenting said meta and performance information to a user (See column 44, lines 50-67); and

presenting a list of said identified available data resources to said user (See column 50, lines 53-67).

As to claim 7, Moran et al. comprising the step of:

receiving access information from said user, wherein said access information comprises one member of the group consisting of a username and a password (See column 18, lines 27-40).

As to claim 8, Moran et al. discloses comprising the steps of:

receiving a list of data sources chosen by said user (See column 17, lines 1-29);

extracting said meta and performance data from said chosen data sources (See column 37, lines 56-67, and see column 38, lines 1-30, for all possibility of collected information); and

presenting said meta and performance data to said user (See column 44, lines 50-67).

As to claim 9, Moran et al. discloses comprising the step of:

utilizing a probe engine to verify whether a service of one of said at least one computer system is responding and if said service responds, said service determines said meta and performance data of an environment in which said service is running (See column 37, lines 39-55, also see column 40, lines 55-62).

As to claim 10, Moran et al. discloses wherein the service probing step is performed for each service of said at least one computer system (See column 6, lines 1-6).

As to claim 11, Moran et al. discloses comprising the step of:

utilizing said probe engine to identify a monitoring information source in said at least one computer system and stores said monitoring information source in a list of detected monitoring information sources (See column 17, lines 31-67, also see column 38, lines 26-30).

As to claim 12, Moran et al. discloses wherein the steps of utilizing the probe engine to identify the monitoring information source and storing the monitoring information source in the list of detected monitored information sources are performed for each monitoring information source of said at least one computer system (See column 17, lines 15-29).

As to claim 13, Moran et al. discloses comprising the step of:

utilizing said probe engine to determine a metric associated with each of said monitoring information sources (See column 37, lines 56-67, and see column 38, lines 1-30, for all possibility of collected information).

As to claim 14, Moran et al. discloses wherein said meta information comprises set-up information of said at least one computer system (See column 17, lines 1-29).

As to claim 16, Moran et al. discloses wherein said list receiving step comprises the step of receiving a range to be examined of said network environment, said range being specified by said user (See column 17, lines 1-29).

As to claim 17, Moran et al. discloses wherein the probe engine corresponds to a service type (See column 57, lines 14-64, shows a list of functionality probe is capable of performing); and

the data source detection module activates the probe engine depending on the service type (See column 38, lines 60-65).

As to claim 18, Moran et al. discloses wherein the lists of the available data sources and the detected metrics output by the data sources detection module are initially empty and are populated while the probe engine identifies all of the available data sources and detected metrics (See column 18, lines 55-67).

As to claim 19, Moran et al. discloses further comprising the step of activating a probe engine according to its service type, wherein the probe engine probes a monitoring information service for monitoring information of the computer system (See column 19, lines 15-20, and see column 42, lines 36-60, also see column 44, lines 50-67).

As to claim 20, Moran et al. discloses further comprising the step of populating the list of the available data sources, wherein the list of the avaible data sources is initially empty (See column 19, lines 15-20, and see column 42, lines 36-60, also see column 44, lines 50-67, wherein "initially empty" reads on "user control" and definition since it can be altered accordingly).

Response to Arguments

10. Applicant's arguments with respect to claims 1-14, and 16-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-Form 892 for List of Cited References.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neveen Abel-Jalil
June 23, 2006